

REMARKS/ARGUMENTS

The office action of September 1, 2004, has been carefully reviewed and these remarks are responsive thereto. Applicant has made various changes to the specification and drawings as further described below. Claims 1-5, 8-10, 15-19, 24, and 26-28 have been amended and new claim 30 has been added. Claims 1-30 thus remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Drawings

The Office Action objects to the drawings for various reasons. First, the drawings stand objected to as not illustrating a telephone as recited in claim 29. However, Applicant notes that drawings are optional in the first place, to be included "where necessary for the understanding of the subject matter sought to be patented." 37 C.F.R. § 1.81. Applicant respectfully submits that one of ordinary skill in the art knows what a telephone is, and will readily understand how it is used with the invention as described throughout the application as filed. Should the examiner disagree, Applicant respectfully requests evidence of the level of knowledge of one of ordinary skill in the art, demonstrating the need for a pictorial illustration of a telephone. Irrespective of the above, the claim to which the Office Action refers is a method claim, which is clearly illustrated in Figures 11A-11C.

The drawings stand objected to because the reference character 1007 was used twice in Figure 10. Applicant notes, however, that this error was previously corrected in the formal drawings as filed April 27, 2001.

The drawings stand objected to because the following references are allegedly not referred to in the application specification: M², 608, 907, 1001, 1002, 1003, 1004, 1005, 1006, 1007, 2103, 2104, 2105, 2106, 2107, and 2108. Applicant points out that M² is referred to through the specification as "square meters," for which M² is a generally accepted abbreviation. The issue is moot, however, as Applicant is presently amending Fig. 3 to refer to "space" instead of "M²," which is what M² represents, as is clear from the context in which it is used.

The Applicant has amended the specification to refer to 608, 907, 1001, 1002, 1003, 1004, 1005, 1006, and 1007, as well as 1008. No new matter has been added.

Reference numbers 2103, 2104, 2105, 2106, 2107, and 2108 are already described in the specification as filed at page 30, line 22.

The Office Action alleges that the description of steps 602-607 is inconsistent with that shown in Fig. 6. Applicant submits, however, that one of ordinary skill in the art would readily understand the nature of steps 602-607 upon reading the detailed description in conjunction with the Figures. Indeed, while the Office Action alleges that the specification indicates steps 607-607 are similar to steps 502-507, no such statement is made. The specification clearly states that steps “602 through 607 are similar in nature to the other steps already discussed.” More steps than just 502-507 have previously been discussed in the application as filed, and one of ordinary skill in the art can readily understand Figure 6.

The drawings stand objected to because the term M^2 used in Fig. 3 is not described in the specification and it is allegedly unclear as to what the term represents. Applicant points out that M^2 is a common symbol to represent “square meters,” and that it is clear from the context in which M^2 is used that M^2 is referring to lease space. This is evidenced by reference to “square meters” throughout the specification as filed, e.g., as indicated by the illustration of a “required space provision of 5000 square feet (automatically converted into square meters by the computer)” at page 20, lines 16-17. Irrespective, Applicant has amended Fig. 3 to refer to “Required Space” instead of “Required M^2 ,” as supported by the specification as filed, to clarify step 301.

Specification

The Office Action objects to the specification for various reasons. Each is discussed in turn below.

Applicant has amended various references to Fig. 11 to read “Fig. 11C” as requested by the Office Action.

The Applicant has declined to amend page 21 as suggested by the Office Action, and respectfully submits that page 21, line 9 is correct as written.

While one of ordinary skill in the art would readily understand that a leasehold investment and leasehold improvement refer to the same subject matter, the Applicant has amended the specification to consistently refer to the acronym LHI as a "leasehold improvement."

Applicant has amended Fig. 5 to be consistent with the description in the specification.

Applicant has removed references to "M²" from Fig. 3 to harmonize Fig. 3 with the specification.

The Office Action alleges that the specification lacks proper antecedent basis for the claimed subject matter, namely "telephone" as recited in claim 29. Applicant directs the Office's attention to page 26, line 24 and page 37, lines 2-4.

The Office Action objects to the specification as allegedly containing browser executable code. However, a web address, without the inclusion of meta tags or the precursor "http://" is not browser-executable, as discussed in MPEP § 608.01 (VII), and is therefore not properly objectionable.

Rejections Under 35 U.S.C. § 112

Claims 8-10 and 27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has amended claim 8 to properly depend from claim 7. Applicant has amended claim 9 to refer to the "revised" project summary report." Applicant has amended claim 10 to properly depend from claim 8. Applicant has amended claim 27 to provide proper antecedent basis.

Rejections Under 35 U.S.C. § 102

Claims 1-5, 11-13, 16-18, 21-24, 28, and 29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Raveis Jr. (U.S. Pat. No. 6,321,202, hereinafter Raveis). Applicants respectfully traverse this rejection for at least the following reasons.

Amended claim 1 recites, *inter alia*:

- (1) receiving over a computer network from one or more parties to the completed real estate transaction information relating to the completed real estate transaction, wherein the information comprises responses to a transaction questionnaire evaluating the real estate transaction;
- (2) generating a transaction report based on the received information;

- (3) storing the transaction report in a computer storage device; and
- (4) in response to a query by a third-party user, transmitting the transaction report over the computer network to the third-party user.

Raveis, however, does not teach or suggest all the recitations of amended claim 1. More specifically, Raveis does not, in response to a query by a third-party user, transmit a transaction report, which is based on received information including responses to an evaluation questionnaire, to the third-party user.

Raveis describes a system and method for managing real estate transactions by storing a database of contacts (buyers and sellers) and vendors. Raveis, Abstract. The Raveis system, based on the occurrence of a particular phase of a real estate transaction, accesses vendor data and sends it to a contact. Raveis does not manage or maintain a database of transaction reports comprising responses to evaluation questionnaires, as claimed.

The Office Action alleges that Raveis, at col. 12, lines 9-11, describes a transaction evaluation questionnaire. However, Raveis at the cited portion recites:

It is envisioned that data relating to contacts and listings
10 will also include a history of all real estate related goods and
services provided. Based upon the history, move consultants
communicate future maintenance reminders to contacts. For

However, a history of goods and services provided is not an evaluation questionnaire. Raveis instead acts similar to a mere listing of service providers. Raveis' only reference to anything resembling an evaluation is at col. 14, lines 8-17, which state:

Still referring to step 250, a survey mechanism within the
system of the subject invention provides for the recording of
10 responses from Customer Surveys. Management can also
generate reports based upon the surveys. The system allows
the company to modify and update surveys. In a preferred
embodiment, customized forms can be created using OMNI-
FORM® 3.0, MICROSOFT WORDS® 97 or ACROBAT®
15 software version 3.0.1 (available from Adobe Systems
Incorporated at 1585 Charleston Road, Mountain View,
Calif. 94397), as is well known by those skilled in the art.

However, Raveis does not teach or suggest that to which the surveys relate, nor does Raveis describe any mechanism whereby a third-party user can query the system for a transaction report

and the system will send the transaction report to the third-party user. Thus, claim 1 is allowable over Raveis.

With respect to claim 2, Raveis does not teach or suggest that a questionnaire includes information identifying a local service provider that assisted with one or more aspects of the real estate transaction. While the Office Action cherry picks a phrase relating to goods and services provided (col. 12, lines 9-11 of Raveis), there is no teaching or suggestion that information identifying a service provider is received via a transaction evaluation questionnaire, as recited in the claim. That is, a general reference to goods and services is not the same as information identifying a service provider being received via a transaction evaluation questionnaire.

Likewise, Raveis does not teach or suggest an evaluation of at least one service provider, as recited in claim 3. The Office Action alleges that such a feature is described in Raveis at col. 12, lines 9-11 and 14-15, where Raveis indicates that "an entry in the history will indicate what vendor and when the cleaning was last performed." However, this is not the same as an evaluation of the at least one service provider, as claimed.

With respect to claim 4, there is no teaching or suggestion in Raveis that the questionnaire includes an evaluation of another *party* to the real estate transaction, much less that the evaluation of the other party is included when sent to the third-party user. The Office Action refers to portions of Raveis describing vendors, which are not parties to real estate transactions as claimed. Indeed, in Raveis, at step 230 of Raveis "a real estate transaction occurs" (col. 13, line 2), and subsequently at step 240 the post-closing marketing of services begins.

Similarly, Raveis does not have a teaching or suggestion that the questionnaire evaluates local challenges encountered during the real estate transaction, as recited in claim 5. Indeed, Raveis instead discusses actions performed by vendors after completion of a real estate transaction.

Claim 11 recites, *inter alia*, "the comment report including at least one comment related to the information in the transmitted transaction report;... and linking the comment report to the stored transaction report." Claim 11 thus requires two linked reports: the initial transaction report based on the evaluation questionnaire, and a subsequent comment report commenting on the evaluation questionnaire. Raveis does not teach or suggest such a feature. The Office Action

alleges that Raveis describes such a feature at col. 13, lines 46-48 and col. 7, lines 20-27. However, Raveis merely states that “a move consultant provides data relating to vendors who provide periodic services as required by contacts and listings.” This is not the same as providing both a transaction report based on a questionnaire, and subsequently providing a comment report related to the transaction report.

With respect to claim 13, Raveis does not teach or suggest that a user can query based on country, city and type of report.

Similar to claim 1, amended independent claim 16 recites:

a computer programmed with software that generates at least one display to receive information related to the real estate transaction from one or more parties to the completed real estate transaction, *wherein the generated display comprises a transaction evaluation questionnaire that facilitates receipt of evaluation data from a user evaluating the real estate transaction*, the computer system generating at least one transaction report from the received information and transmitting the transaction report over a computer network to a third-party user in response to a request....

(emphasis added). As discussed above, Raveis neither teaches nor suggests a transaction evaluation questionnaire, which is then stored in a database and can be queried by a third-party user. Claim 16 is therefore allowable for similar reasons as claim 1. Claims 17-18 and 21-24 are allowable based on the allowability of claim 16, and further for similar reasons as claims 2-5 and 11-13.

Amended independent claim 28 recites, *inter alia*, “receiving in the computer from one or more parties to a completed real estate transaction information evaluating the completed real estate transaction,” which information is then stored and can be queried by a third-party user. Claim 28 is therefore allowable for similar reasons as claim 1. Claim 29 is allowable based on the allowability of claim 28.

Rejections Under 35 U.S.C. § 103

Claims 6, 14, 19, and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Raveis in view of D'Alessandro (U.S. Pat. No. 6,556,974). This rejection is respectfully traversed.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, the Office Action provides no suggestion or motivation to combine Raveis with D'Alessandro. The Office Action states that it would have been obvious to combine the references in order to “ensure that a respondent has completed a particular questionnaire related to the real estate transaction.” (with respect to claims 6 and 19) or to “analyze the evaluation information for real estate transaction services provided by a local service provider” (with respect to claims 14 and 25). These are not motivations to combine references, however, but rather are *results of the combination only after the examiner has benefited from reading Applicant's own disclosure*, and are thus impermissible hindsight. That is, the Office Action provides no motivation or suggestion to combine the real estate transaction management system of Raveis with the business performance evaluation system of D'Alessandro in the first place.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there is no motivation or suggestion to combine Raveis with D'Alessandro. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at

the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant's disclosure, as would be required to make such an allegation. Thus, the combination is an improper combination based on hindsight reasoning.

Even if Raveis and D'Alessandro could be combined, the resulting combination does not teach or suggest every recitation of any claim. For example, with respect to claims 6 and 19, neither Raveis nor D'Alessandro teach or suggest prompting a user to complete a project summary report including a description of tasks required to complete the real estate transaction. The Office Action's reference to D'Alessandro, Fig. 4, ref. 320 and 140 appears irrelevant to the completion of a project summary report. Indeed, if a question is unanswered, D'Alessandro does not allow the method of Fig. 4, to even proceed, but instead enters a continuous loop until all questions have been answered.

Claims 7-10, 15, 20, and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Raveis and D'Alessandro, and further in view of PMBOK Guide (book, A guide to the project management body of knowledge). This rejection is respectfully traversed because, as with the § 103 rejection above, there is no motivation or suggestion to combine Raveis and D'Alessandro. The Office Action likewise fails to provide a motivation or suggestion to combine PMBOK Guide with either Raveis and/or D'Alessandro.

In addition, even if the references could be combined, the combination does not teach or suggest all the recitations of any claim. For example, with respect to claims 15 and 26, none of the references describe linking a local service provider comment report to a plurality of transaction reports having information evaluating the local service provider. Indeed, claims 15 and 26 are not even addressed by the Office Action with respect to this rejection, and Applicant thus lacks a fair opportunity to respond to the rejection of claims 15 and 26 over Raveis, D'Alessandro, and PMBOK guide. Claims 15 and 26 have been amended to be in independent form.

Claims 15 and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Raveis and D'Alessandro, and further in view of Morton (U.S. Pat. No. 6,438,564). This rejection is respectfully traversed because, as with the § 103 rejection above, there is no motivation or

suggestion to combine Raveis and D'Alessandro. The Office Action likewise fails to provide a motivation or suggestion to combine Morton with either Raveis and/or D'Alessandro.

More specifically, the Office Action alleges it would have been obvious to combine Morton with Raveis and/or D'Alessandro in order to "evaluate the local service provider." This alleged motivation suffers the same flaw as above, namely, that it is the *result of the combination only after the examiner has benefited from reading Applicant's own disclosure*, and is thus is also impermissible hindsight. Claims 15 and 26 have been amended to be in independent form.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,
BANNER & WITCOFF, LTD.

Dated this 28th day of February, 2005

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Amendments to the Drawings:

The attached sheets of drawings includes changes to Fig. 3 and Fig. 5. These sheets, which include Fig. 3 and Fig. 5, replace the original sheets including Fig. 3 and Fig. 5.

Attachment: Replacement Sheets (2)